

SN 10/645,447

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ricky W. Purcell

Examiner: Isis Ghali

Serial No.: 10/645,447

Group Art Unit: 1615

Filed: August 20, 2003

Docket: 1443.051US1

For: A SYSTEM FOR PROVIDING THERAPY TO A PORTION OF A BODY

APPEAL BRIEF UNDER 37 CFR § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on December 3, 2007 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on October 11, 2007, from the Final Rejection of claims 40-43-46 and 47 of the above-identified application, as set forth in the Final Office Action mailed on August 9, 2007.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$510.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee,
KIMBERLY-CLARK WORLDWIDE, INC.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The application was filed on August 20, 2003 with claims 1-31.

A Preliminary Amendment was filed on May 2, 2006 cancelling claims 1-31 and adding new claims 32-62.

A Restriction Requirement was mailed on October 11, 2006.

A non-final Office Action was mailed on May 2, 2007.

A non-final Office Action was mailed on June 6, 2007.

A final Office Action was mailed on July 26, 2007.

An Advisory Action was mailed on September 4, 2007.

Claims 44-45 and 48 have been cancelled, and claims 32-39, 49-62 have been withdrawn.

Claims 40-43 and 46-47 are pending, stand twice rejected, and are the subject of the present appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated May 19, 2004.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, A System for Providing Therapy to a Portion of a Body.

INDEPENDENT CLAIM 40

Figure 1 illustrates a system 10 for providing therapy to a portion of a body. The system 10 includes a holder, such as container 12, and a first patch 14 that is held by the container 12. As shown in **Figure 2**, the first patch 14 applies a first therapy to the portion 101 of the body 100 when the first patch 14 is placed on, or near, the portion 101 of the body 100. The system 10 further includes a second patch 16 that is held by the container 12. The second patch 16 applies a second therapy to the portion 101 of the body 100 when the second patch 16 is placed near the portion 101 of the body 100. It should be noted that second patch 16 may be applied near the portion 101 of the body 100 instead of the first patch 14. The choice of which patch (14 or 16) to apply will depend on the type of therapy required by the injured portion 101.

Referring to **Figures 1 and 2**, the system 10 may further include a flexible wrap 20 for supporting a portion 101 of a body 100 and securing one or more of the patches 14, 16, 18 near the portion 101 of the body 100. The flexible wrap 20 is secured relative to the body 100 at a location near the injured portion 101 of the body. The pack 14 (and/or other packs) is then placed against the injured portion 101 of the body 100. The pack 14 is held in place by wrapping the flexible wrap 20 around the injured portion 101 of the body 100. The flexible wrap 20 is spiraled around the body 100 until an end of the flexible wrap 20 is secured to an already-wrapped section of the flexible wrap 20. (See Appellant's spec. at page 4, lines 23-32 and page 5, line 28 through page 6, line 3).

DEPENDENT CLAIM 41

In the sample system 10 illustrated in **Figure 1**, a third patch 18 is held by the container 12. The third patch 18 applies a third therapy to the portion 101 of the body 100 when the third patch 18 is placed near the portion 101 of the body 100. Although three patches 14, 16, 18 are

shown in **Figure 1**, the number and type of patches may vary depending on the type of system. (See Appellant's spec. at page 5, lines 3-8).

DEPENDENT CLAIM 42

In the sample system 10 illustrated in **Figure 1**, the first patch 14 may be an exothermic heating patch, the second patch 16 may an endothermic cooling patch, and the third patch 18 may be a topical or transdermal analgesic patch. (See Appellant's spec. at page 5, lines 8-10).

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to each of the appended claims and its legal equivalents for a complete statement of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 32-62 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-39 of co-pending Application No.

10/954,764 in view of US 5,741,510.

Claims 40, 41, 43, 46 and 47 were rejected under 35 U.S.C. 102(b) as being anticipated by US 4,592,358.

Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,592,358 in view of US 6,245,347).

7. ARGUMENT

A) Discussion of the provisional rejection of claims 32-62 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-39 of co-pending Application No. 10/954,764 in view of US 5,741,510.

Appellant traverses the rejection and will consider whether filing a Terminal Disclaimer is appropriate when all claims are indicated to be otherwise allowable and if some overlap arises between the subject matter of the present application and any allowed claims of co-pending Application No. 10/954,764.

B) The Applicable Law under 35 U.S.C. §102(b)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. PPG Industries, Inc. V. Guardian Industries Corp., 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

C) Discussion of the rejection of claims 40, 41, 43, 46 and 47 under 35 U.S.C. 102(b) as being anticipated by US 4,592,358.

Claims 40, 41, 43, 46 and 47 were rejected under 35 U.S.C. 102(b) as being anticipated by US 4,592,358. Appellant respectfully submits that '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in claim 40.

Appellant further notes that the therapeutic device 10 disclosed in '358 only describes cooling OR heating packets (see '358 at col. 3, line 12, 27, 37). Therefore, Appellant respectfully submits that '358 does not teach or suggest that the cooling OR heating packets are

within the therapeutic device 10 at the same time such that disclosed therapeutic device 10 does not hold packets that apply different types of therapy as recited in claim 40. In addition, Appellant respectfully submits that ‘358 does not teach or suggest “a third patch held by said holder, wherein said third patch applies a third therapy . . . , the third therapy being different than the first and second therapies, wherein the first patch, the second patch, the third patch and the flexible wrap are all within the same compartment in the container” as recited in claim 41.

The Examiner states at page 8 of the Final Office Action that “The container does not impart patentable weight with regard to 102 rejection absent functional relationship between the container and the product, and because the product still function equally effectively with or without the container.” Appellant respectfully traverses both parts of the assertion.

Appellant respectfully traverses the first part of the assertion in part because Appellant cannot see why a functional relationship must be imparted between the container and the first and second patches in order to make claim 40 patentable. Appellant notes that claim 40 defines a structural relationship between the container and the first and second patches by reciting “wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container” which is not described in ‘358.

Appellant respectfully traverses the second part of the assertion in part because Appellant does not understand the relevance of the statement. Appellant initially notes that Appellant’s system would not function as effectively without a container. As discussed in Appellant’s spec. at page 8, lines 6-10, a container is required in order to “reduce the amount of therapy-related items that would otherwise need to be inventoried in order to provide the ability to apply different types of therapy to an injured portion of a body.” (See also Appellant’s spec. at page 2 lines 22-26). Appellant further notes that whether “the product still function equally effectively with or without the container” is not relevant to patentability as ‘358 must still describe “wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container” as recited in claim 40.

The Examiner also states at page 8 of the Final Office Action that “The reference teaches three types of therapy: cooling or heating packets or weights for any particular application. Therefore, these patches are disclosed by the prior art.”

Appellant respectfully traverses this assertion. Appellant initially submits that ‘358 teaches holding cooling packets OR heating packets within the therapeutic device 10 such that ‘358 does not describe “a first patch held by said container, wherein said first patch applies a first therapy” AND “a second patch held by said container, wherein said second patch applies a second therapy.” Appellant also respectfully submits that ‘358 teaches that the flexible wrap is the container instead of the flexible wrap being within the container such that ‘358 does not describe “a flexible wrap held by said container . . . wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container” as recited in claim 40.

Appellant further respectfully notes with regard to the assertion made by the Examiner relating to the weight disclosed in ‘358 that the weight does not provide any type of therapy. Therefore, the weight is not a “a third patch held by said container, wherein said third patch applies a third therapy . . . the third therapy being different than the first and second therapies” as recited in claim 41. Appellant further respectfully submits that (i) the weight is incapable of providing any type of therapy; and (ii) ‘358 does not include any description as to the weight providing any type of therapy.

In addition, Appellant respectfully notes that ‘358 describes inserting only one type of packet into separate compartments 12 of therapeutic device 10. Therefore, ‘358 does not describe placing more than one packet (whether they are the same type or not) into the same compartment within a container as recited in claim 40.

The Examiner further states at page 8 of the Final Office Action that “Regarding Appellant's argument that different therapies are applied at the same time, such limitation is directed to the intended use that imparts no patentability to claims directed to product.” Appellant respectfully traverses this assertion because the Examiner has misconstrued Appellant's argument.

Appellant submits that claim 40 defines a system where the system includes (i) a first patch that applies a first therapy; (ii) a second patch that applies a second therapy; and (iii) a flexible wrap where the first patch, second patch and flexible wrap are all within the same compartment in the container at the same time and the first therapy is different than the second therapy. Appellant again notes that ‘358 only describes placing one type of packet within the therapeutic device at the same time (i.e., heating OR cooling packets).

The Examiner states at pages 8-9 of the Final Office Action that “In any event, the multiple packs of the prior art can be used to provide different therapies at the same time. For example, cold packs can be used in traumatically injured patient that is suffering from bruise, burn and bone fracture. Cold packs can be applied for these three different injuries to provide different therapies at different sites of the body at the same time.” Appellant respectfully traverses this assertion and submits that in Examiner’s scenario, the therapeutic device 10 disclosed in ‘358 would be applying the one type of therapy (i.e., cooling therapy) to three different locations on the body instead of using three different patches that apply three different types of therapy as recited in claim 41.

D) The Applicable Law under 35 U.S.C. §103(a)

To sustain a rejection under 35 U.S.C. 103, references must be cited that teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

E) Discussion of the rejection of claim 42 under 35 U.S.C. 103(a) as being unpatentable over US 4,592,358 in view of US 6,245,347).

Appellant respectfully traverses the rejection because the combination of ‘358 and ‘347 does not describe each and every element of the claimed invention, and combining ‘358 with ‘347 by altering the ‘358 to include a control apparatus 100 as disclosed in ‘347 would destroy the stated purpose of ‘347.

I. '358 and '347 do not teach or suggest every element of claim 42

As discussed above, '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in claim 40. Appellant further notes that there does not appear to any disclosure in '347 related to a holder or container that secures the disclosed patches. Therefore, Appellant respectfully submits that combination of '358 and '347 does not teach or suggest where first and second patches are within the same compartment in a container at the same time and are able to apply different types of therapy as recited in claim 40.

Appellant notes that claim 42 depends from claim 40, and as such incorporates all of the limitations of claim 40. Therefore, Appellant respectfully submits that the combination of '358 and '347 does not teach or suggest a system as recited in claim 42.

II. Combining '358 and '347 would destroy the stated purpose '347

As discussed above, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

Combining '358 with '347 by altering the '358 to include a control apparatus 100 as disclosed in '347 would destroy the stated purpose of '347 which is the "**administration of drugs.**" (See '347 at column 3, lines 54-56). Appellant notes that placing the apparatus 100 into the compartments 12 of '358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin (which is required for the apparatus 100 in '347 to function properly).

The Examiner also states at page 12 of the Final Office Action that "In response to Appellant's argument that placing the control apparatus 100 into the compartments 12 of '358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin, it is argued that '347 is relied upon for the solely teaching of analgesic patch and for teaching the combination of endothermic, exothermic and analgesic patch in one device."

Appellant initially submits that the only description as to placing an endothermic, exothermic and analgesic patch within the same compartment in a container is found Appellant's specification and claims. Appellant further notes that '358 does not include any description as to removing any of heating OR cooling packets in order to provide therapy. The therapeutic device 10 disclosed in '358 is meant to operate by inserting heating OR cooling packets into compartments 12 and then securing the therapeutic device 10. Appellant again notes that placing apparatus 100 of '347 into the therapeutic device 10 of '358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin to administer drugs, which is contrary to the specific purpose of '347.

Since combining '358 with '347 would destroy the stated purpose of '347, the rejection was improper.

SUMMARY

For the reasons argued above, claims 40, 41, 43, 46 and 47 were not properly rejected under 35 U.S.C. 102(b) as being anticipated by US 4,592,358; and claim 42 was not properly rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,592,358 in view of US 6,245,347.

It is respectfully submitted that the art cited does not render the claim anticipated and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26 day of December 2007.

CANDIS BUENDING
Name

Ando Brendy
Signature

8. CLAIMS APPENDIX

40. A system for providing therapy to a portion of a body, the system comprising:
- a container that includes at least one compartment;
 - a first patch held by said container, wherein said first patch applies a first therapy to the portion of the body when said first patch engages the portion of the body;
 - a second patch held by said container, wherein said second patch applies a second therapy to the portion of the body when said second patch engages the portion of the body, the second therapy being different than the first therapy; and
 - a flexible wrap held by said container, the flexible wrap being adapted to secure at least one of said first patch and said second patch to the portion of the body, wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container.
41. The system of claim 40 further comprising a third patch held by said container, wherein said third patch applies a third therapy to the portion of the body when said third patch is placed near the portion of the body, the third therapy being different than the first and second therapies, wherein the first patch, the second patch, the third patch and the flexible wrap are all within the same compartment in the container.
42. The system of claim 40 wherein said first patch is an exothermic heating patch and said second patch is an endothermic cooling patch, and wherein said third patch is a topical analgesic patch.
43. The system of claim 40 wherein said first patch is within a first enclosure and said second patch is within a second enclosure.
46. The system of claim 40 further comprising a plurality of first patches held by said container.

47. The system of claim 40 wherein said first patch and said second patch are releasably attached to said container.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.